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## PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

P13753-US1

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on March 28, 2007

Signature Pamela S. Newton

Typed or printed name Pamela S. Newton

Application Number

09/943,211

Filed

August 30, 2001

First Named Inventor

Per Magne Hoff, et al.

Art Unit

2617

Examiner

Genack, Matthew W.

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor.

☐ assignee of record of the entire interest.  
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.  
(Form PTO/SB/96)

☒ attorney or agent of record. 50,298  
Registration number \_\_\_\_\_

☐ attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34 \_\_\_\_\_

Michael Cameron

Signature

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Typed or printed name

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Telephone number

3/28/07

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below\*.

☒ \*Total of 1 forms are submitted.

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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Applicants:	Per Magne Hoff, et al.	§	Group Art Unit:	2617
		§		
Serial No:	09/943,211	§	Examiner:	Genack, Matthew
		§		
Filed:	August 30, 2001	§	Appeal No.:	8840
		§		

For: OVERLOAD PROTECTION IN PACKET COMMUNICATION NETWORKS

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Date: March 28, 2007

  
Pamela S. Newton

Dear Sir:

**PRE-APPEAL BRIEF REQUEST FOR REVIEW**

Issues regarding the Pre-Appeal Brief Request are as follows:

**PENDING REJECTIONS**

In the Office Action mailed January 17, 2007, claims 1, 6 and 9-10 and 12 were rejected under 35 U.S.C. 103(a) as being unpatentable over Li et al., (US 6,591,301) (Li) in view of Haumont et al., (US 6,233,458) (Haumont) further in view of Ekman et al., (US 5,960,355) (Ekman); claims 3 and 7 were rejected under 35 U.S.C. 103(a) as being unpatentable over Li, in view of Haumont, further in view of Ekman, and further in view of Maruyama (US 6,430,272) (Maruyama); and claims 11 and 13 were rejected under 35 U.S.C. 103(a) as being unpatentable over Li, in view of Haumont, further in view of Ekman, and further in view of En-Seung (US 6,892,306) (En-Seung).

## **ARGUMENTS**

### **Claims 1, 6, 9-10 and 12**

Regarding claims 1, 6 and 9-10 and 12, the Examiner stated that Li discloses a method for controlling the processing of messages by a packet-based network gatekeeper in order to prevent the gatekeeper's processor from crashing, wherein messages relating to calls in progress are handled preferentially relative to messages relating to new calls. The Examiner further stated that Li discloses that if the frequency of messages associated with new calls exceeds a certain threshold, "in-progress message favoring" may be invoked. The Examiner also stated that Li discloses that the message type is determined by examining the message header and if the call is associated with a new call, then the message is discarded.

Claims 1 and 6 recite that the method is carried out by a serving general packet radio service support node (SGSN) after the SGSN is re-started or by a base station system (BSS) after the BSS is re-started. Examiner admits that Li does not disclose that the method is conducted by an SGSN after the SGSN is re-started. Examiner then states that Haumont merely discloses that a SGSN may need to be shut down after a malfunction or due to a high level of traffic. The Applicant acknowledges that SGSNs may be shutdown at various times and Haumont does disclose this. However, Haumont merely discloses this shutdown in the context of a re-routing procedure which changes a key network element in a connection without interrupting the traffic. Haumont does not teach or suggest providing any type of overload protection in packet communication networks after re-starts of an SGSN. Examiner further states that neither Li nor Haumont expressly disclose the handling of situations where a BSS is restarted. Examiner then states: "Procedures for handling the restart of a radio base station are disclosed (Column 9 Line 66 to Column 10, Line 13, Fig. 4)" (See last line of page 3 and top line of page 4 of the Office Action). However, Ekman does not teach or suggest procedures for restarting radio bases stations, much less does Ekman provide any type of overload protection in packet communication

networks after the re-start of a BSS. The pertinent portion of column 9, line 66 to column 10, line 13 provides:

The frame number FR-NR is otherwise used in conjunction with encryption but regarding the present invention it allows supervising *when something unusual occurs such as a restart of a radio base station which makes measurements useless if* involving the time before and after such an event. Such measurements are discarded by the positioning algorithm if indicated by the frame number FR-NR.

The italicized portion makes passing reference to the restart of a radio base station—but does not discuss procedures for restarting a radio base station. Nor does Figure 4 discuss restarting a radio base station (See col. 9, lines 26-29). In essence, Figure 4 describes a process undertaken by the mobile terminal when it is switched on. Ekman discusses a method for geographically positioning a first mobile radio terminal within a radio network having unsynchronized radio base stations by using a plurality of second fixed radio terminals whereby the positions of the radio base stations and the second fixed radio terminals are known.

Li, Haumont and Ekman discuss different solutions to different problems from each other and from the Applicant's invention, and hence there is no teaching, motivation or suggestion for combining these references. It is important to recognize that "[w]hen an obviousness determination relies on the combination of two or more references, there must be some suggestion or motivation to combine the references." *WMS Gaming Inc. v. International Game Technology*, 51 USPQ 2d 1385, 1397 (Fed. Cir. 1999). As reiterated and emphasized by the Federal Circuit, such a requirement is a powerful protection against impermissible hindsight reconstruction:

"Combining prior art references without evidence of ... a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability – the essence of hindsight...[citations omitted]." *In re Dembiczak*, 50 USPQ 2d 1614, 1617 (Fed. Cir. 1999).

In this case, Li discloses a method for controlling network gatekeeper message processing. Quite distinctly, Haumont discloses a re-routing processing by modifying key network elements and Ekman discloses positioning a mobile radio terminal within a radio network having unsynchronized radio base stations. There is no motivation for combining these references which describe three different and entirely distinct areas of network technology. Therefore, the Applicant respectfully submits that the combination of Li, Haumont and Ekman is improper since a claimed invention can not be obvious without a demonstration of the existence of a motivation to combine those references at the time of the invention. Indeed, the only teaching or suggestion that supports the combination of these references is found in the teaching of the present application. In short, this is a classic case of hindsight reconstruction in which the present patent application has been used as "a guide through the maze of prior art references, combining the right references in the right way so as to achieve the result of the claims in suit." *Orthopedic Equip. Co. v. United States*, 702 F.2d 1005, 1012, 217 USPQ 193, 199 (Fed. Cir. 1983).

Claims 9-10 and 12 depend from claim 6 and recites further limitations in combination with the novel elements of claim 6. Thus, the Applicant respectfully requests the withdrawal of the §103(a) rejection and the allowance of claims 1, 6 and 9-10 and 12.

### **Claims 3 and 7**

The Examiner rejected claims 3 and 7 under 35 U.S.C. 103(a) as being unpatentable over Li in view of Haumont, further in view of Ekman and further in view of Maruyama. The Examiner stated that Maruyama discloses a procedure for processing messages according to a user's wishes at a message processing apparatus in a communication system. Claims 3 and 7 depend from independent claims 1 and 6, respectively, and recite further limitations in combination with the novel and unobvious elements of claims 1 and 6. As discussed above, claims 1 and 6 recite a method which is carried out by a SGSN after the SGSN is re-

started or by a BSS after the BSS is re-started. The combination of Li, Haumont, Ekman and Maruyama does not teach or suggest a method which is carried out by a SGSN after the SGSN is re-started or by a BSS after the BSS is re-started. Thus, the Applicant respectfully requests the withdrawal of the §103(a) rejection and the allowance of claims 3 and 7.

### **Claims 11 and 13**


The Examiner rejected claims 11 and 13 under 35 U.S.C. 103(a) as being unpatentable over Li, in view of Haumont, further in view of Ekman and further in view of En-Seung. Claims 11 and 13 depend from independent claim 6 and recite further limitations in combination with the novel and unobvious elements of claim 6. As discussed above, the combination of Li with Haumont and Ekman is improper because there is no motivation to combine these references. The addition of En-Seung does not make up for the missing elements of Li. Thus, the Applicant respectfully requests the withdrawal of the §103(a) rejection and the allowance of claims 11 and 13.

### **CONCLUSION**

In view of the foregoing remarks, the Applicant believes all of the claims currently pending in the Application to be in a condition for allowance. The Applicant, therefore, respectfully requests that the Panel withdraw all rejections and issue a Notice of Allowance for all pending claims.

Respectfully submitted,

Date: 3/28/07

  
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